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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS : FRANKLIN ,et al.
SERIAL NO. : 09/938,269
FILED : August 23, 2001
FOR : Treatment of Trauma

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450
Mailstop: Amendment

SIR:

Election of Invention in Response to Restriction Requirement

In response to the Examiner's office action dated October 1, 2004 in the above-referenced patent application, Applicant elects to prosecute the invention of group I, claims 1-19 and 21-26, drawn to a method of treating inflammatory disease with polyanionic polymer, classified in class 424, subclass 78.06. Applicants also elect to prosecute a species wherein the inflammatory disease is internal trauma, in particular adhesion, and wherein the polyanionic polymer is a clearable polymer (microgel) further defined as being a crosslinked homopolymer or copolymer of acrylic acid (carbopol) wherein the linking moiety is a degradable mono- or diester. Claims 1, 2, 3, 5, 8, 9, 10, 11, 12, 14, 21, 22, 23 and 24 are readable on the elected species. Applicants suggest that the species be broadened to include a crosslinked homopolymer or copolymer of acrylic acid wherein the linking moiety is degradable. This would allow prosecution to proceed on a much more efficient basis.

Applicants respectfully submit that restriction to the suggested species group election would not be so narrow as to unnecessarily restrict prosecution and would also avoid unnecessarily burdening the Examiner in examining the instant application. Applicants respectfully request that the Examiner give careful consideration to examining the suggested species/invention group in determining the appropriateness of this restriction. Applicants further respectfully submit that it is not cogent to suggest that limiting the examined invention to the restricted species is necessary given that the broader suggested species group would be easily searched and examined.

Notwithstanding Applicants' election, Applicants respectfully traverse the Examiner's requirement for restriction. Applicants respectfully request reconsideration of the Examiner's requirement for election. Applicants respectfully submit that prosecution of all of the originally filed claims should not be restricted to the elected species group. It is respectfully submitted that the pending claims are directed to pre-formed hydrolytically susceptible polyanionic polymers which may be used to treat adhesions and the invention as originally claimed may be readily examined.

According to M.P.E.P. §803, restriction by the Examiner of patentably distinct inventions is proper if the claimed inventions are independent and a serious burden would be placed on the Examiner if restriction was not required. Applicants respectfully submit that the presentation of the originally filed claims would not place such a serious burden on the Examiner as to require restriction.

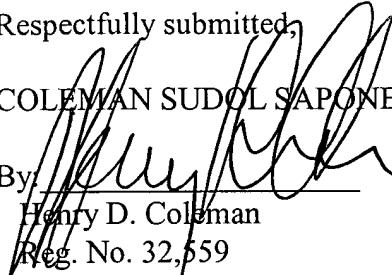
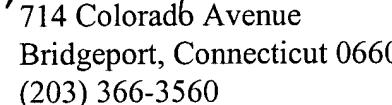
Although the claimed methods which are used in the present methods are generally patentably distinct from each other, Applicants respectfully submit that any search the Examiner would need to conduct in examining the instant application set forth in all of the originally filed claims would not be unduly burdensome. Moreover, the examination of these claims would not place such a serious burden on the Examiner as to require restriction.

Applicants understand the general policy considerations for the Patent Office's requirement for restriction in certain instances. In this instance, however, those considerations do not weigh in favor of restricting the inventions here. In determining the appropriateness of restriction, one must also consider the countervailing consideration that, in each instance, Applicant wishes the Patent Office to examine his or her application with a certain degree of "administrative efficiency" and wishes to have patent claims issue which reflect the breadth of his or her invention. The balance that is to be weighed should be tipped in this instance by the fact that the claimed methods set forth in the originally filed claims are sufficiently narrow to weigh on the side of examining all the claims indicated above, especially in light of the conceptual limitations of the claimed polymers which are useful within the claimed methods.

Applicants respectfully submit that the originally filed claims are sufficiently narrow to allow the Examiner to determine patentability without being subjected to the serious burden

referred to in M.P.E.P. §803. Consequently, Applicant respectfully requests that the Examiner examine all of the claims in the present application.

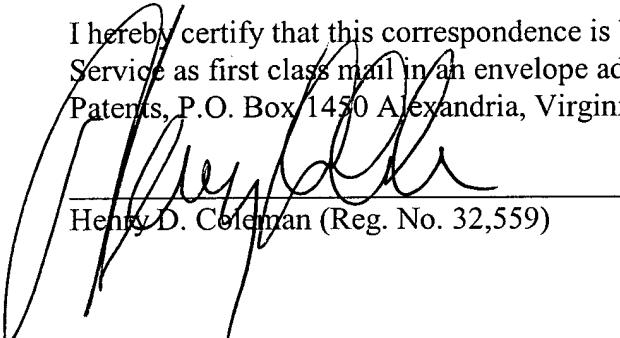
No fee is believed due for the submission of this response. A revocation of power of attorney and appointment of substitute counsel paper along with an attached assignment document is also enclosed.

Respectfully submitted,

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Dated: October 18, 2004

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450 Alexandria, Virginia 22313-1450 on October 19, 2004.


Henry D. Coleman (Reg. No. 32,559)